

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Rule 53(b) Continuation)
Application of:)
Hans-Willi JANSEN et al.)
Parent Application No.: 09/779,587) Parent Group Art Unit: 1636
Parent Filed: February 9, 2001) Examiner: Not Yet Assigned

For: PROCESS FOR IDENTIFYING SUBSTANCES WHICH MODULATE THE
ACTIVITY OF HYPERPOLARIZATION-ACTIVATED CATION CHANNELS

Assistant Commissioner for Patents
Washington, D.C. 20231

PETITION TO ACCEPT APPLICATION WITHOUT DRAWINGS

Sir:

In a Notice of Incomplete Nonprovisional Application mailed in parent application Serial No. 09/779,587, dated December 7, 2001, the Office indicated that, although the specification of the application made reference to drawings (figures), no drawings were filed with the application. Applicants submit that the drawings (Figures 1 and 2) discussed in the text of the specification are not necessary for the understanding of the subject matter sought to be patented. Therefore, Applicants submit that the drawings are not required under 35 U.S.C. § 113.

The present invention and an advantage it provides over previously known methods are briefly summarized in the specification, on page 14, lines 20-24. The two figures referenced in the specification depict examples of results obtained according to practice of the invention with a combination of a publicly-available instrument (FLIPR, Molecular Devices, Sunnyvale CA; see

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the specification at page 11, lines 27-28 and page 21, line 7 through page 22, line 8) and well-known and widely used cations (sodium (Na^+), potassium (K^+), and cesium (Cs^+)), cation channel modulators (forskolin and zatebradine; see the specification at page 3, lines 15-28 and page 9, lines 15-27) , and ion channels (HCN family; see the specification at page 10, lines 9-12), all of whose identities and modes of action are known to those of skill in the art. (See the specification at page 21, line 17 through page 22, line 8; and page 22, line 21 through page 23, line 3.) The figures do not provide necessary information for understanding the invention, but merely show examples of results that can be obtained by practicing the invention.

Furthermore, the invention is not limited to the instrument, cations, modulators, and channels used to generate the data of the figures. Rather, the invention can be practiced using various instruments that are publicly available from various scientific instrument suppliers. (See, for example, the specification at page 5, lines 1-6.) Likewise, it can be practiced on numerous ion channels that are affect by various different modulators and cations. (See the specification at page 9, lines 15-27; page 10, lines 9-23; page 14, lines 20-26; and page 15, lines 12-17.) Thus, the invention is not limited to the instrument, cation channel, cation, or modulator used in the experiments presented as the figures of the application. Accordingly, the data provided by the figures is not necessary to understand or practice the invention, but merely illustrative of one embodiment of it.

Finally, the text of the specification, without the figures, clearly and adequately describes the full scope of the claimed invention. See, for example, page 20, line 15 through page 21, line 15 (according to the paragraph, as amended by the Preliminary Amendment filed herewith); and

page 22, lines 23-19 (according to the paragraph, as amended by the Preliminary Amendment filed herewith).

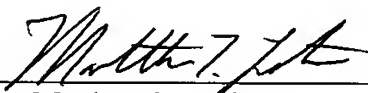
In view of the above discussion, Applicants respectfully submit that the specification fully describes the subject matter of the claimed invention without any need for either of Figures 1 and 2. Accordingly, the figures and accompanying text (which is deleted by the Preliminary Amendment filed herewith) are not necessary for the understanding of the subject matter sought to be patented, and are thus not required under 35 U.S.C. § 113. Therefore, Applicants respectfully request that the Office accord this application the filing date of February 7, 2002, and enter the accompanying Preliminary Amendment, which eliminates the text relating to Figures 1 and 2.

The required Petition fee under 37 C.F.R. § 1.17(h) of \$130.00 is attached hereto. Because this application is entitled to the filing date of February 7, 2002, Applicants request that the attached Petition fee be refunded upon granting of the filing date by the Office.

If there is any other fee due in connection with the filing of this Petition, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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